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Carlos O. Pinzon

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EXAMINER

VENKAT, JYOTHSNA A

ART UNIT

PAPER NUMBER

1619

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/733,900	Applicant(s) PINZON ET AL.	
	Examiner JYOTHSNA A. VENKAT	Art Unit 1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 355-368 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 355-368 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/5/09</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Receipt is acknowledged of amendment, remarks, terminal disclaimer and IDS filed on 2/5/09.

Status of claims

Claims 1-354 are cancelled. Claims 355-368 are pending in the application.

In view of terminal disclaimer, the obviousness-type double patenting rejection of claims 355-367 over commonly owned U. S. Patents 6,716,420, 6,835,399, 6,869,594, 6,881,400, 6,979,469, 7,008,619, 7,011,823, 7,025,953, 7,276,547, 7,314,612, 7,351,418, and 7,410,636 is hereby withdrawn.

The following new ground of rejection under 112, 2nd paragraph is necessitated by the amendment.

Claim Rejections - 35 USC § 112

Claims 356, 358, 361, 363, 365 and 368 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 356, 358, 361, 365 and 368 lacks antecedent basis with respect to “ said composition “. Claims recite “ cosmetic composition”.

Claims 358 and 365 recite “ a method comprising applying a cosmetic composition”. Claims are ambiguous and lack clarity. Note that there are claims drawn to method of making and method of using therefore claims 358 and 365 are unclear as to applicants' intent.

The following rejections are maintained.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 355-361 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is new matter rejection.**

There is no support in the specification for claims drawn to the species belonging to structuring polymer, which is **“ethylenediamine/stearyl dimer tallate copolymer”**.

Specification at page 12, ll 14-25 teaches:

“Non-limiting examples of an at least one polyamide polymer which may be used in the composition according to the present invention include the commercial products sold by Arizona Chemical under the names Uniclear 80 and Uniclear 100. These are sold, respectively, in the form of an 80% (in terms of active material) gel in a mineral oil and a 100% (in terms of active material) gel. These polymers have a softening point ranging from 88°C to 94 °C, and may be mixtures of copolymers derived from monomers of (i) C36 diacids and (ii) ethylenediamine, and have a weight-average molecular mass of about 6000. Terminal ester groups result from esterification of the remaining acid end groups with at least one alcohol chosen from cetyl alcohol and stearyl alcohol. A mixture of cetyl and stearyl alcohols is sometimes called cetylstearyl alcohol”.

The specification teaches the species, which can be formed from (i) C36 diacids and ethylenediamine and the terminal ester groups result from esterification of the remaining acid

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end groups can be with cetyl alcohol or the species can be formed from (ii) C36 diacids and ethylenediamine and the terminal ester groups result from esterification of the remaining acid end groups can be with stearyl alcohol or the species can be formed from (ii) C36 diacids and ethylenediamine and the terminal ester groups result from esterification of the remaining acid end groups can be with a mixture of cetyl and stearyl alcohols also known as cetylstearyl alcohol.

There is no support in the specification for species claimed in claims 355-361 since the species is a copolymer of ethylene diamine and tall oil dimer acid monomers end blocked with stearyl alcohol. Tall oil contains fatty acids mainly of palmitic acid, oleic acid and linoleic acid. See below for the definition of Tall oil.

From Wikipedia, the free encyclopedia

Tall oil, also called **liquid rosin** or **tallol**, is a viscous yellow-black odorous liquid obtained as a byproduct of the Kraft process of wood pulp manufacture. The name originated as anglicization of Swedish "tallolja" ("pine oil"). Crude tall oil contains rosin, unsaponifiable sterols (5-10%), resin acids (mainly abietic acid and its isomers), fatty acids (mainly palmitic acid, oleic acid and linoleic acid), fatty alcohols, some sterols, and other alkyl hydrocarbon derivatives. By fractional distillation, **tall oil rosin** is obtained, with rosin content reduced to 10-35%. By further reduction of the rosin content to 1-10%, **tall oil fatty acid (TOFA)** can be obtained, which is cheap, consists mostly of oleic acid, and is a source of volatile fatty acids. The rosin finds use as a component of adhesives, rubbers, and ink, and as an emulsifier. The pitch is used as a binder in cement, an adhesive, and an emulsifier for asphalt. TOFA is a low-cost alternative to tallow fatty acids for production of soaps and lubricants. When esterified with pentaerythritol, it is used as a compound of adhesives and oil-based varnishes. Tall oil is also used in oil drills as a component of drilling fluids.

Thus tall oil acid is not a C36 dicarboxylic acid, therefore there is no support for the claimed species.

In response to Rule 105 request applicants submit as Exhibit 1, page 606 of the International Cosmetic Ingredient Dictionary and Handbook ("CTFA"), which recites that ethylenediamine/stearyl dimer dilinoleate copolymer is a copolymer of ethylenediamine and stearyl dimer dilinoleate monomers and further reciting that a trade name for ethylenediamine/stearyl dimer dilinoleate copolymer is Uniclear® and the same page also recites that ethylenediamine/stearyl dimer tallate copolymer is a copolymer of ethylenediamine and tall oil dimer acid monomers, end blocked with stearyl alcohol and further recites that a trade name for ethylenediamine/stearyl dimer tallate copolymer is Uniclear®. The cosmetic dictionary

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submitted to show support for the claimed specie is after the filing date of the instant application.

Applicants also submit as exhibit 2, a redacted version of confidential proprietary documents from the Assignee Company. See below

Réf. Commerciale	Fabricant / Distributeur
UNICLEAR 100 VG	REDACTED
(DGT) UNICLEAR 100 VG	
Nom chimique R.A.D :	CONDENSAT DIACIDE EN C36 HYDROGENE ETHYLENE DIAMINE, ESTERIFIE PAR ALCOOL STEARYLIQUE (PM: ENVIRON 4000) ETABLISE (ANOX 20)
Nom INCI USA :	ETHYLENEDIAMINE/STEARYL DIMER DILINOLEATE COPOLYMER

The redacted document shows that Uniclear®100VG is also known as ethylenediamine stearyl dimer dilinoleate copolymer and this species is described since linoleic acid is 18 carboxylic diacid and the dimer acid is C36 carboxylic acid. This species is claimed in claims 362-368.

However, the first page of the redacted document does not state that Uniclear®100 V is ethylenediamine/tall oil dimer acid/stearyl alcohol copolymer (emphasis added), which is the species claimed in claims 355-361. Compare page 2 to page1.

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REDACTED

Nom Chimique : CONDENSAT DIACIDE EN C36 HYDROGENE/ETHYLENE DIAMINE, ESTERIFIE PAR
ALCOOL STEARYLIQUE

Nom CTFA :

REDACTED

Références commerciales

Références commerciales	Fournisseurs
UNICLEAR 100 V	REDACTED

REDACTED

Numéro de CAS	Nom CTFA substance	Nom européen substance	% sub.	Rôle	Type	Color index	% etiq.	N° cines
REDACTED	ETHYLENEDIAMINE/TALL OIL DIMER ACID/STEARYL ALCOHOL COPOLYMER				REDACTED			
	REDACTED							

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Search on Arizona Chemical Company website showed the following:

Air Care / Personal Care Gellants

Product	Softening Point, C, Ring & Ball	Viscosity cps/mPa-s @ 160 C	Acid No.	Color, Gardner	Amine No.	Flash Point, F
Uniclear® 100	88-100	90-140	12	1-2	≤1.0	520
Uniclear® 100LM	75-80	90-140	12	1-2	≤1.0	520
Uniclear® 100VG*	88-98	100-160	12	1-3	≤1.0	520
Sylvaclear™ C75V*	70-80	90-160	25	1-3	≤1.0	508

* Vegetable dimer based resin

The softening point and viscosity are different for Uniclear ® 100 and Uniclear ® 100 VG. Search on Arizona Chemical Company website did not show softening point and viscosity for Uniclear ® 100 V described at top portion of page 1 of the redacted copy. There is no Uniclear ® 80 on the website.

Therefore, there is no support for the claimed species and claims 355-361 are drawn to new matter.

Response to Arguments

Applicant's arguments filed 2/5 /09 have been fully considered but they are not persuasive.

Applicants' argue:

“In addition to the extensive evidence and statements already of record, Applicants now submit herewith as Exhibit 1, a redacted copy of an Expert Report of Robert Lochhead, Ph.D., submitted on December 15, 2006, in *L'Oreal S.A. v. Ester Lauder Co.*, Civil Action No. 04-1660 (HAA) (D.N.J. filed Apr. 7, 2004), and as Exhibit 2, a letter from the Cosmetic Toiletry and Fragrance Association ("CFTA") dated December 14, 1999, and relied upon in the Expert Report. At

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paragraph 14 of his report, Dr. Lochhead states that persons skilled in the art reading the disclosure regarding Uniclear® in the specification of the patent at issue (which corresponds to the present specification) would have understood that the inventors contemplated use of ethylenediamine/stearyl dimer tallate copolymer as a structuring polymer. Applicants submit that the teachings provided in the information already of record, as well as the teachings provided by the additional evidence submitted herewith, show that the ethylenediamine/stearyl dimer tallate copolymer was known by those of ordinary skill as Uniclear® at the time of filing of the present application. Accordingly, Applicants submit the specification, as filed, provides written description support for claims 292,294,296 and 298”.

In response to the above argument, Dr. Lochhead might assert that persons skilled in the art reading the disclosure regarding Uniclear® in the specification would have understood that the inventors contemplated use of ethylenediamine/stearyl dimer tallate copolymer as a structuring polymer. However, the evidence from the redacted documents discussed above clearly indicates that UNICLEAR 100V and UNICLEAR 100VG are different polymers and that one cannot conclude that any composition whose name includes UNICLEAR® necessarily includes the same polymer.

In this regard the CTFA website states: Trade Names are unique identifiers that are assigned to a cosmetic ingredient by the manufacturer or supplier of that ingredient. These names are often designed to reflect a particular company's product line, and do not necessarily have any direct relationship to the chemical nature of the ingredient. The passage cited above suggests that

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as of December 1999 that the trade name UNICLEAR was associated with the tallate copolymer. However, this does not establish that the same was true as of applicant's filing date. Applicant's redacted documents clearly indicate a plurality of polymers associated with UNICLEAR as of applicant's filing date.

Arizona Chemical Website suggests that there are unspecified differences between the various UNICLEAR® products and that absent objective evidence one cannot conclude that the reference to UNICLEAR 100 in the instant specification refers to ethylenediamine/stearyl dimer tallate copolymer.

A further complication is that the CTFA from 2002 clearly sets forth that the UNICLEAR® is associated with both the dilinoleate species and the tallate species. Therefore there is no support in the specification for species claimed, which is ethylenediamine/stearyl tallate copolymer.

Claims 355-368 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims recite “at least one structuring polymer chosen from ethylenediamine/stearyl dimer tallate copolymer” or “at least one structuring polymer chosen from ethylenediamine/stearyl dimer dilinoleate copolymer”. The expression “chosen from” implies more than one Markush member. There is only one copolymer therefore the expression “at least one” and “chosen from” lacks clarity and the claims do not particularly point out the subject matter which the applicant regards as his invention.

Response to Arguments

Applicant's arguments filed 2/5/09 have been fully considered but they are not persuasive.

Applicants' argue:

“Contrary to the Examiner's assertions, the use of the phrase "at least one" along with the phrase “chosen from,” does not render the claims unclear. As presently written, the claimed compositions, which comprise "at least one structuring polymer," can include more than one structuring polymer as long as one of the structuring polymers in the claimed composition is the claimed copolymer. Therefore, despite the Examiner's assertions, the scope of the subject matter embraced by the claims is clear and definite”.

In response to the above argument, claims recite the species, which are ethylenediamine/stearyl dimer dilinoleate copolymer and ethylenediamine/stearyl dimer tallate copolymer. The expression “ at least one structuring polymer chosen from ethylenediamine/stearyl dimer dilinoleate copolymer” implies another polymer besides dilinoleate polymer. the same is true for “at least one structuring polymer chosen from ethylenediamine/stearyl dimer tallate copolymer”.

The claims are ambiguous and a person of ordinary skill in the art could not interpret the metes and bounds of the claims so as to understand to avoid infringement. Deletion of “ at least one structuring polymer chosen from “ is suggested.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 355-368 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 5,783,657 ('657) and 6,423,324 ('324).

Patent '657 teaches polymer having gel consistency and these gels are useful in personal care products where in some self-supporting consistency is desired. See the abstract and see cols. 3-4 and see col.3, lines 31-36 where patent teaches that these polymers are useful in cosmetic art. Patent at col.4, ll 20-25 teaches ester –terminated polyamide of formula I (ETPA).

The species claimed in the instant application belong to the genus of this polymer (formula I). The species are formed from ethylenediamine, stearyl alcohol and tall oil fatty acid or ethylenediamine, stearyl alcohol and linoleic acid. Patent at col.5, ll 1-20 describes the definition of R1 and the carbon range of 16-22 is the preferred range. Patent at col.5, ll 23-33

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teaches the definition of R2 and at col.5, ll 39-40 teaches that typical unsaturated acids are linoleic acids and at col.5, ll 44-46 teaches that tall oil fatty acid is a preferred source of long-chain fatty acids. Patent at col.7, ll 24-35 teaches the preparation of ETPA . The starting materials for the ETPA are alcohols, amines and carboxylic acids are preferred starting materials (col.7, ll 24-25). Patent at paragraph bridging col.s 7-8 describes the monoalcohols and at col.8, line 3 describes preferred R1 and this includes stearyl alcohol (*one of the reactants, namely alcohols for the formation of both the claimed species*). Patent at col.8, ll 37-68 describes the second component, which is diacid and at col.9, ll 5-15 describes the acids and this includes linoleic acid (*one of the reactants, namely acids for the formation of ethylenediamine/stearyl dimer dilinoleate copolymer*) and describes the preferred fatty acid as tall oil fatty acid (*one of the reactant, namely acids for the formation of ethylenediamine/stearyl dimer tallate copolymer*). Patent at col.9, ll 24-28 describes that polymerized fatty acids are sold under the trade name UNIDYME®. Patent at col.10, ll 18-36 describes exemplary diamines and the ethylenediamine (*one of the reactants, namely amines for the formation of both the claimed species*) is the first diamine described at line 20. Patent at col.12 through col.13, line 45 describes in detail the preparation of ETPA resins.

Patent '657 at col.14, lines 30-42 teaches that the polymer can be formulated into various personal care products. This includes deodorant, eye make-up, lipstick, foundation make-up, bay-oil, skin moisturizers, sun care products, lip balm, ethnic hair care products.

Patent '657 at col.17, ll 25-26 suggests adding ingredients that are conventionally incorporated into personal care products and suggests that gels which are formed from ETPA

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resin and low-polarity liquids can be combined with water, colorants, emulsifiers, and fillers and also teaches adding wax.

Patent '647 teaches adding emulsifiers also known as surfactants. The difference between the patent and instant application is patent '647 does not teach claimed oil soluble cationic surfactant.

However, patent '324 teach combining structurally related polyamide resins with surfactants, including cationic surfactants, for reducing susceptibility of the composition to syneresis, modifying viscosity and improving the texture of the composition. Patent at the paragraph bridging cols. 8-9 teaches that the composition can include blend of surfactants and patent at col. 10 teaches that in addition to non-ionic surfactants, cationic or anionic surfactants can be used. See col. 9, lines 1-5; col. 10, lines 46-52. The useful cationic surfactants include oil-soluble cationic surfactants such as quaternary ammonium compounds and fatty amines. Patent '324 teaches the advantages of using polyamide resin and blend of surfactants, which has the advantage of inhibiting hardening and loss of rub off availability. This loss of rub off availability is very popular among the consumer since these products are called "transfer resistant products".

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of by using the species belonging to ETPA of patent '657 that is formed from linoleic acid, stearyl alcohol and ethylenediamine and also the species formed from tall oil fatty acid, stearyl alcohol and ethylenediamine and combine with oil soluble cationic surfactant of patent '324. One of ordinary skill in the art would be motivated to combine polyamide gellant (species claimed) of '657 with cationic surfactants taught by patent '324 with the reasonable expectation of success that the compositions have the

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advantage of providing the consumer stable cosmetic products having structured property and gel property and when the polymer is combined with the cationic surfactants of patent '324 it has the additional advantage of inhibiting hardening and loss of rub off availability. This is a prima facie case of obviousness.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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